

Serial No. 09/395,206
Amdt. dated May 30, 2003
Reply to Office Action of August 30, 2003

Docket No. P-035

REMARKS/ARGUMENTS

Favorable reconsideration and allowance of the present patent application are respectfully requested in view of the foregoing amendments and the following remarks. Claims 1-20 are pending in the application. Claims 1-6, 8-11 and 16-20 are rejected. Claims 7 and 12-15 are objected to. Claims 1, 4 and 10-12, 16, and 19 have been amended.

Applicants gratefully acknowledge the courtesies extended by Examiner Nguyen to Applicant's representative, John Ciccozzi, during an August 25, 2003 telephonic interview. During the interview, claim 1 and other rejected claims were discussed and the Applicant's representative argued the claims to be allowable over the Nagata et al. and Akiyoshi references. The substance of the personal interview is incorporated in the following remarks and amendments to the claims.

No exhibit was presented or demonstration conducted during the interview.

Applicant respectfully requests that this paper be included in the record for purposes of satisfying the requirements under MPEP

The Applicants would like to thank the Examiner for the telephonic interview that was granted on August 25, 2003 to discuss the merits of the pending case.

The Applicants sincerely thank the Examiner for indicating that claims 7 and 12-15 contain allowable subject matter. The Applicants would like to reserve the right to re-write the claims pending further prosecution on the merits.

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The Examiner states that the Applicants arguments previously presented in the Amendment filed on March 17, 2003 have been fully considered, but have been rendered moot in view of the new grounds of rejection. Therefore, the Applicants will now address the new grounds of rejection.

A. Drawings *OK*

The Applicants have addressed the Examiner's concerns regarding the drawings in a separate drawing correction letter that is being submitted concurrently with this amendment under separate cover. Figure 5, S55 has been amended to read "Extracting Test Pattern Data From Output Side Device" as the Examiner correctly noted.

Regarding claim 12, the claim has been amended to read "extracting a test pattern from the output side device." This element now corresponds to S55 shown in Figure 5 as corrected.

Claims 1 and 4 were objected to because of minor informalities. These claims have been amended to address the Examiner's concerns. Therefore, it is respectfully submitted that the objection be withdrawn and that the claims be allowed. *OK*

B. 35 U.S.C. § 112

Claim 12 is rejected under 35 U.S.C. 112, first paragraph as allegedly failing to comply with the enablement requirement. Applicants respectfully traverse the rejection. *OK*

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Claim 12 has been amended to address a typographical error that appears in the claim. Therefore, the Applicants submit that this amendment addresses the Examiner's concern and that the claim does now comply with the enabling requirement. It is respectfully submitted that the rejection be withdrawn and that claim 12 be allowed. *ok 112 -> other claim?*

C. 35 U.S.C. § 102(e)

Claims 1-4 are rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Nagata (U.S. Patent No. 6, 181, 680). Applicants respectfully traverse the rejection.

The Applicants respectfully submit that the claims have been amended in a manner to further clarify the Applicants' claimed invention and to incorporate the substance of the discussion conducted with the Examiner during the telephonic interview. Also, the Applicants respectfully submit that the present claim amendments have rendered the rejection moot.

The support for the addition of the word "automatically" to claims 1, 10, 11, 16, and 19 and "without user action" to claim 10 is found at least on page 6, lines 4-7 of the specification. The specification states that:

In the database formation step S10, a device controller checks a valid path state of each board which forms the switch network in an

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initial state step S11, and the checked state is outputted to the main processor, and the main processor forms a database for the checked state in step S12.

Note that it is a device controller that checks a valid path state and the checked state is outputted to the main processor. These functions are performed automatically at the processor level and do not require manual intervention on the part of the user as required in Nagata, col. 3, lines 11-15, where an "input from a maintenance console connected to the cell switching machine" is needed.

Furthermore, with respect to claims 1-4, Applicants respectfully submit that Nagata does not disclose every feature as required under § 102.

For example, claim 1 is broadly directed towards a switching system which includes a plurality of devices formed in a dual active structure, a device controller that controls the devices, and a main processor, a path management and testing method used in a switching system. The device controller checks a valid path and state change for each board, forming a database using a main processor, searching the database and confirming a standby path, and performing a path test for the entire interval or a certain interval with respect to the active or standby path.

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In contrast, Nagata discloses a communication monitoring method for a cell switching machine that includes setting up a virtual communication path, including a path within the cell switching machine in compliance with a communication path connection request made by a user to the cell switching machine. Continuity of the virtual communication path is tested by transmitting a maintenance cell from the cell switching machine through the virtual communication path after setting up the virtual communication path and before initiating user cell transmission through the virtual communication path.

The Office Action asserts that col. 3 lines 11-15 of Nagata discloses using the device controller to check a valid path and state change for each board for forming a database using the main processor. The Applicants respectfully submit that this is not an accurate characterization of the applied reference.

The specific portion of Nagata referred to in the Office Action states “when a point-to-multipoint connection with a plurality of leaf points is set up in the cell switching machine, recording correspondence between each leaf point and a physical connection point in a table.”

A leaf point in a network refers to those points that are located in the outer periphery or fringes of a network, similar to the leaves of a tree. This portion of Nagata does not teach

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or suggest using a device controller to check a valid path and state change for each board as recited in claim 1 of the Applicants' invention.

Additionally, the Office Action asserts that col. 3, lines 11-15 discloses searching the database and confirming a standby path. The Applicants respectfully submit that this is also not an accurate characterization of the applied reference.

The specific portion of Nagata referred to in the Office Action states "when a maintenance cell loopback test request, designating a specific leaf point, is input from a maintenance console connected to the cell switching machine, determining the physical connection point corresponding to the specific leaf point by referring to the table." There is no teaching or suggestion of searching the database and confirming a standby path as claimed by the Applicants in claim 1. 

The applied portion of the reference clearly states that one must designate a specific leaf point and there must be an input from a maintenance console connected to the cell switching machine.

Finally, the Office Action asserts that col. 3, lines 43-47 discloses performing a path test for the entire interval or a certain interval with respect to the active or standby path. The

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Applicants respectfully submit that this is not an accurate characterization of the applied reference.

The specific portion of Nagata referred to in the Office Action states that “means for performing a maintenance cell loopback test on a virtual communication path by periodically inserting a maintenance cell in a flow of user cells being transmitted along the virtual communication path.”

There is no teaching of performing a path test for the entire interval or a certain interval with respect to the active or standby path.

Further, as stated in MPEP § 2131, “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F. 2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). As noted above, Nagata does not disclose at least checking a valid path and state change for each board, searching a database and confirming a standby path and performing a path test for the entire interval or a certain interval with respect to the active or standby path. Therefore, Nagata cannot anticipate Applicant’s claimed combinations as alleged by the Examiner.

For at least the reasons mentioned above, it is respectfully submitted that the rejection be withdrawn and that claim 1 be allowed.

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Claims 2-4 are dependent claims that depend on independent claim 1 and should be allowable for at least the same reasons as claim 1 as well as the additionally recited features.

Claims 10-11, 16 and 19 are rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Akiyoshi (U.S. Patent No. 5, 715, 237). Applicant respectfully traverses the rejection.

Claim 10 is directed towards a switching system of a dual active structure, an actual active path judging method including automatically checking an active path formed in a direction of a matched last receiving board at a receiving side terminal. An active path is checked in the reverse direction of a data transmission direction and searching an entire active path by checking a switching path of the board connected to the active path.

In contrast, Akiyoshi discloses an inter digital switching equipment relay system and digital switching equipment having a plurality of digital switching equipments connected each other through a trunk line, for transferring a block of digital data containing an item of destination data from the one digital switching equipment to the other digital switching equipment via the trunk line. The relay system includes a backup trunk line arranged in parallel to said trunk line between the plurality of digital switching equipments and having substantially the same capacity as that of the trunk line; and transferring means, provided in the one digital switching equipment, for transferring, in case a data quantity of the block of the digital data passing through the trunk line becomes a fixed threshold value or larger, part

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
of the block of the digital data passing through the trunk line to the other digital switching equipment via the backup trunk line.

The Office Action asserts that col. 17, lines 46-54 discloses checking an active path formed in a direction of a matched last receiving board at a receiving side terminal. The Applicants respectfully submit that this is not an accurate characterization of the applied reference.

The specific portion of Akiyoshi referred to in the Office Action states:

Further, the cell transmitter 121a incorporates a function to transmit an ATM-OAM cell outputted from the memory (RAM) 16 to a switching network via the trunk line $\phi 1$ or the subscriber line $\phi 3$ in accordance with an indication given from the main control unit 14 (see FIG. 25). Further, the cell receiver 121b has a function to receive the ATM-OAM cell sent via the trunk line $\phi 1$ and notify the main control unit (CTL) 14 of it through the memory (RAM) 16 (see FIG. 26) and also a function to transfer the ATM-OAM cell to the ATM cell switch (SW) 11 (see FIG. 27).

There is no teaching or suggestion of checking an active path formed in a direction of
a matched last receiving board at a receiving side terminal as claimed by the Applicants. The parenthetical comment provided in the Office Action stating "sending OAM message on the trunk line" does not teach or suggest the features claimed by the Applicants.

Additionally, Akiyoshi does teach or suggest "checking an active path in the reverse  direction of a data transmission direction."

Additionally, the Applicants respectfully submit that in the Office Action, a prima facie case for obviousness under 35 U.S.C. § 103 has not been established. As discussed

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above, the applied references singly or in combination fail to teach or suggest all of the features claimed by the Applicant. Furthermore, there is no suggestion or motivation in the references themselves to modify the reference or to combine reference teachings. The teaching or suggestion to make the modification or combination of prior art and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. *In re Vaeck*, 947, F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

For at least the reasons mentioned above, it is respectfully submitted that the rejection be withdrawn and that claim 10 be allowed.

Claim 11 recites features that are related to the features recited in claim 10 and therefore, should be allowable for at least the same reasons presented above. There is no teaching or suggestion of at least checking an active path formed in a direction of a matched last receiving board, there is no checking of an active path in the reverse direction of a data transmission direction and there is no performing a path test with respect to the set standby path.

In col. 29, lines 46-48, Akiyoshi discloses "there is deleted the routing table set to the input-directional ATM header high-speed converting circuit (ATC) 122a connected to the backup line Φ 2." Again, there is no teaching or suggestion of setting a reverse path of the active path as a standby path.

For at least these reasons, it is respectfully submitted that the rejection be withdrawn and that claim 11 be allowed.

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Independent claims 16 and 19 recites features that are related to the features recited in claims 1 and 11 respectively, and therefore, should be allowable for at least the same reasons presented above regarding claims 1 and 11.

D. 35 U.S.C. § 103

Claims 5-6 and 8-9 are rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Nagata in view of Chen (U.S. Patent No. 5,659,540). Applicants respectfully traverse the rejection.

Claims 5-6 and 8-9 are dependent claims that depend upon independent claim 1 and should be allowable for at least the same reasons as independent claim 1 as well as the additionally recited features in the claims.

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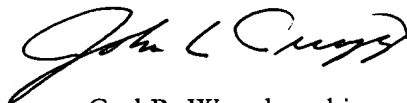
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CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance. If the Examiner believes that any additional changes would place the application in better condition for allowance, the Examiner is invited to contact the undersigned attorney, **JOHN L. CICCOTZI**, at the telephone number listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 16-0607 and please credit any excess fees to such deposit account.

Respectfully submitted,
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